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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,256	08/31/2006	Kenji Hisatomi	2006_1248A	8260
52349 7590 08/18/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
			EXAMINER RUST, ERIC A	
			ART UNIT 2625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/591,256

Applicant(s)

HISATOMI ET AL.

Examiner

ERIC A. RUST

Art Unit

4146

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 31, 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 08/31/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-24 are pending in this application.

Priority

2. Acknowledgment is made of Applicants' claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy of Application No. 2004-187000, filed on June 24, 2004 has been received by the Office.

Drawings

3. The drawings are objected to because Figure 1 should be designated by a legend such as --Prior Art-- since only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 and 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to claims 1, 17, and 21, the claims recite units (e.g., print content generation unit, print content reception unit, etc.) that are nothing more than software as evidenced by the Applicants' disclosure (specification at [0016], and claim 19).

In regard to claims 2-16 and 22-24, the claims are dependent from claim 1 and claim 21 respectively, and fail to rectify the problem in claim 1 and claim 21 respectively.

In regard to claim 18, claim 18 is rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claim recites a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In order for a process to be "tied" to another

statutory category, the structure of another statutory category should be positively recited in a step or steps significant to the basic inventive concept, and NOT just in association with statements of intended use or purpose, insignificant pre or post solution activity, or implicitly.

In regard to claim 19, the claim recite a program, i.e., a functional descriptive material, which by itself is not one of the statutory subject matters. However, the claim does not define a "computer-readable storage medium or computer-readable memory" and is thus non-statutory for that reason. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, and 17-20 are rejected under 35 U.S.C. 103(a) as being obvious in view of U.S. Patent No. 6,738,587 B1 to Hoene et al. (hereinafter, Hoene).

In regard to claim 1, Hoene discloses print system (**Hoene, Fig. 1**) comprising:

a print content generation unit (**Hoene, Fig. 2, item 216**) operable to generate or acquire print content that includes a control code and image data (**Hoene, col. 5, lines 15-16, when printing, generating or acquiring print content that includes a control code and image data is inherent**);

an image data determination unit (**Hoene, Fig. 2, item 200**) operable to determine whether or not the image data included in the generated or acquired print content can be used for printing (**Hoene, col. 5, lines 25-30**);

a photo printing judgment unit (**Hoene, Fig. 2, item 200**) operable to judge whether or not the printing to be performed using the print content is intended for photo printing (**Hoene, col. 7, lines 5-8**).

a printing control unit (**Hoene, Fig. 2, item 200**) operable to change details of printing processing in accordance with a determination result given by said image data determination unit and a judgment result given by said photo printing judgment unit (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is changing the details of print processing**).

In regard to claim 17, Hoene discloses a print apparatus (**Hoene, Fig. 1**) comprising:

a print content reception unit (**Hoene, col. 5, lines 15-16, this recitation makes a print content reception unit inherent**) operable to receive print content that includes

a control code and image data (**Hoene, col. 5, lines 15-16, when printing, receiving print content that includes a control code and image data is inherent**);

an image data determination unit (**Hoene, Fig. 2, item 200**) operable to determine whether or not the image data included in the received print content can be used for printing (**Hoene, col. 5, lines 25-30**);

a photo printing judgment unit (**Hoene, Fig. 2, item 200**) operable to judge whether or not the printing to be performed using the print content is intended for photo printing (**Hoene, col. 7, lines 5-8**).

a printing control unit (**Hoene, Fig. 2, item 200**) operable to change details of printing processing in accordance with a determination result given by said image data determination unit and a judgment result given by said photo printing judgment unit (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is changing the details of print processing**).

In regard to claim 18, Hoene discloses a print method (**Hoene, Fig. 1, the method is inherent**) comprising:

a print content reception step of receiving print content that includes a control code and image data (**Hoene, col. 5, lines 15-16, when printing, receiving print content that includes a control code and image data is inherent**);

an image data determination step of determining whether or not the image data included in the received print content can be used for printing (**Hoene, col. 5, lines 25-30**);

a photo printing judgment step of judging whether or not the printing to be performed using the print content is intended for photo printing (**Hoene, col. 7, lines 5-8**).

a printing control step of changing details of printing processing in accordance with a determination result given in said image data determination step and a judgment result given in said photo printing judgment step (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is changing the details of print processing**).

In regard to claim 19, Hoene discloses a program for a print apparatus, said program being capable of causing a computer to execute (**Hoene, col. 4, line 26**):

a print content reception step of receiving print content that includes a control code and image data (**Hoene, col. 5, lines 15-16, when printing, receiving print content that includes a control code and image data is inherent**);

an image data determination step of determining whether or not the image data included in the received print content can be used for printing (**Hoene, col. 5, lines 25-30**);

a photo printing judgment step of judging whether or not the printing to be performed using the print content is intended for photo printing (**Hoene, col. 7, lines 5-8**).

a printing control step of changing details of printing processing in accordance with a determination result given in said image data determination step and a judgment

result given in said photo printing judgment step (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is changing the details of print processing**).

In regard to claim 20, Hoene discloses a computer-readable recording medium which stores a computer-executable program (**Hoene, col. 4, lines 26-29**), said program comprising:

a print content reception step of receiving print content that includes a control code and image data (**Hoene, col. 5, lines 15-16, when printing, receiving print content that includes a control code and image data is inherent**);

an image data determination step of determining whether or not the image data included in the received print content can be used for printing (**Hoene, col. 5, lines 25-30**);

a photo printing judgment step of judging whether or not the printing to be performed using the print content is intended for photo printing (**Hoene, col. 7, lines 5-8**).

a printing control step of changing details of printing processing in accordance with a determination result given in said image data determination step and a judgment result given in said photo printing judgment step (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is changing the details of print processing**).

In regard to claim 2, Hoene further discloses wherein said printing control unit is operable to abort the printing to be performed using the print content, when said image data determination unit determines that the image data cannot be used for the printing and said photo printing judgment unit judges that the photo printing is intended (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is aborting the printing**).

In regard to claim 3, Hoene further discloses wherein nothing is printed when the printing is aborted (**Hoene, col. 5, lines 25-29, and col. 7, lines 34-37, not permitting a print job and/or making recommendations both result in nothing being printed when the printing is aborted**).

In regard to claim 5, Hoene further discloses a printing unit (**Hoene, Fig. 1, item 104**) operable to perform the printing on a print medium using the print content (**Hoene, col. 7, lines 29-32**),

wherein the determination by said image data determination unit as to whether or not the image data can be used for the printing and the judgment by said photo printing judgment unit as to whether or not the photo printing is intended are made before the printing unit performs the printing on the print medium (**Hoene, col. 7, lines 29-32, impermissible print parameter or adverse printing result are determined before the data is sent to the printer**).

6. Claims 4 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoene in view of Applicant Admitted Prior Art (hereinafter, AAPA).

In regard to claim 4, Hoene does not disclose wherein said printing control unit includes an alternative representation generation unit operable to generate or store an alternative representation that replaces the image data in the printing processing,

wherein said alternative representation generation unit is operable to generate a character or a mark that replaces the image

when said image data determination unit determines that the image data cannot be used for the printing and said photo printing judgment unit judges that the photo printing is not intended, and

said printing control unit is operable to replace a print part of the image data included in the print content with a print of the alternative representation.

AAPA, however, discloses when print data is abnormal, printing is not aborted and alternative text is printed (**Applicants' specification, pg. 2, line 32 - pg. 3, line 5**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hoene with the teachings of AAPA so that when text is being printed, and the print data is abnormal, alternative text is printed.

The motivation is so that a user could be notified of the abnormal print data. Moreover, in cases where the print data being abnormal only results in minor issues with the final print (e.g., final print data being blurred in certain areas when transferred

to the print medium), a user not needing an exact representation of the print data could would not have to reprint the print data.

In regard to claims 13-16, Hoene does not disclose wherein said image data determination unit is operable to determine whether or not the image data can be used for the printing on the basis of whether or not the image data can be acquired from a host apparatus; or wherein said image data determination unit is operable to determine whether or not the image data can be used for the printing on the basis of whether or not information indicating a print inhibition is appended to the image data; or wherein said image data determination unit is operable to determine whether or not the image data can be used for the printing on the basis of whether or not a data format of the image data can be handled by a print apparatus which performs the printing; or wherein said image data determination unit is operable to determine whether or not the image data can be used for the printing on the basis of whether or not the image data has an abnormality.

AAPA, however, discloses wherein it is judged whether image data can be used for the printing on the basis of whether or not the image data can be acquired from a host apparatus (**Applicants' specification, pg. 1, line 30, the Examiner reads "image data access disabled" meaning that image data cannot be acquired from a host apparatus**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hoene with the teachings of AAPA in order to widen the application of Hoene.

The limitations of claims 14-16 are nothing more than reciting what other kind of issues would make image data unable to be used for printing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use any of the limitations of claims 14-16 for the determining if image data can be printed in order to widen the application of the system disclosed in Hoene.

7. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoene in view of U.S. Patent Application Publication No. 2002/0135626 A1 to Sato et al. (hereinafter, Sato).

In regard to claim 6, Hoene does not disclose wherein said print content generation unit is operable to generate or acquire the print content including the control code in which a photo tag indicating the photo printing is described, and

said photo printing judgment unit is operable to judge that the photo printing is intended when the photo tag is included in the control code.

Sato, however, discloses wherein a user can select photographic print mode (**Sato, Fig. 5, item IM, and [0028], lines 4-8**). In is inherent in Sato that some type of flag would have to be included in the command code after the user selects a print mode.

Otherwise, the printer would not be able to determine the print mode that was selected by the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hoene with the teachings of Sato, in regard to placing a photo tag in the print command code, so that the printer knows what type of printing the user selected.

In regard to claim 7, neither Hoene or Sato disclose wherein said print content generation unit is operable to generate or acquire the print content including the control code in which a name of a photo printing application program is described, and

said photo printing judgment unit is operable to judge that the photo printing is intended when the name of the photo printing application program is included in the control code.

It would have been obvious to one of ordinary skill in the art at the time of the invention to place a photo printing application program name in the command code in order to widen the application of the system disclosed in Hoene.

8. Claims 8-12, 21-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoene in view of U.S. Patent Application Publication No. 2004/0196509 A1 to Cousins et al. (hereinafter, Cousins).

In regard to claims 8-12, Hoene does not specifically disclose an input instruction determination unit operable to receive an instruction from a user and to determine whether or not the received instruction is an instruction specific to the photo printing, wherein said photo printing judgment unit is operable to judge that the photo printing is intended when the received instruction is judged to be the instruction specific to the photo printing; or wherein said photo printing judgment unit is operable to judge that the photo printing is intended when the received instruction is judged to be an instruction to print one image per piece of a print medium; or wherein said photo printing judgment unit is operable to judge that the photo printing is intended when the received instruction is judged to be an instruction to use photo paper; or wherein said photo printing judgment unit is operable to judge that the photo printing is intended when the received instruction is judged to be an instruction to request borderless printing; or wherein said photo printing judgment unit is operable to judge that the photo printing is intended when the print content is generated or acquired by a digital camera.

Cousins, however, discloses wherein it is judged that photo printing is intended when a received instruction is judged to be the instruction specific to the photo printing (**Cousins, Fig. 5, item 88, [0038], lines 13-15, and [0040], lines 1-9**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hoene with the teachings of Cousins in order to allow a user a user friendly way control printing operations.

The limitations of claims 9-12 are nothing more than reciting what kind of user instruction is received from the user.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use any of the limitations of claims 9-12 for the user instruction in order to widen the application of the system disclosed in Hoene.

In regard to claim 21, Hoene discloses a print apparatus equipped with a printing unit which performs printing on a print medium using print content (**Hoene, col. 5, lines 6-46**), said print apparatus comprising:

an image data determination unit (**Hoene, Fig. 2, item 200**) operable to determine whether or not image data included in the print content can be used for the printing (**Hoene, col. 5, lines 25-30**);

a printing control unit (**Hoene, Fig. 2, item 200**) operable to abort the printing when said image data determination unit judges that the image data cannot be used for the printing and when photo printing is intended (**Hoene, col. 1, lines 61-62, col. 5, lines 6-10, i.e., interrupting the print job is aborting the printing**).

Hoene does not specifically disclose a medium detection unit operable to detect a type of the print medium which is used by said printing unit;

a photo print media table in which types of print media used for photo printing are described;

a photo printing judgment unit operable to judge whether or not the photo printing is intended, on the basis of details described in said photo print media table and the type of the print medium detected by said medium detection unit; and

Cousins, however, discloses a medium detection unit (**Cousins, [0033], line 3, media sensor**) operable to detect a type of the print medium which is used by said printing unit (**Cousins, [0033], lines 1-7**);

a photo print media table (**Cousins, table 2 at the bottom of pg. 4**) in which types of print media used for photo printing are described (**Cousins, table 2 at the bottom of pg. 4**);

a photo printing judgment unit (**Cousins, [0032], lines 1-3, and [0033] lines 1-9, the cited recitations make a photo printing judgment unit inherent**) operable to judge whether or not the photo printing is intended, on the basis of details described in said photo print media table and the type of the print medium detected by said medium detection unit (**Cousins, [0032], lines 1-3, and [0033] lines 1-15**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hoene and Cousins in order to give an accurate and easy way to determine if photo printing is intended.

In regard to claim 22, Hoene and Cousins discloses claim 21. Moreover, Cousins discloses wherein said photo printing judgment unit is operable to judge that the photo printing is intended, when the type of the print medium is one of photo paper, glossy paper, ink-jet paper, sticker paper, dye sublimation print paper, and postcard paper (**Cousins, [0033], lines 7-9**).

In regard to claim 24, Hoene and Cousins discloses claim 21. Moreover, Hoene discloses wherein nothing is printed on the print medium when the printing is aborted (**Hoene, col. 5, lines 25-29, and col. 7, lines 34-37, not permitting a print job and/or making recommendations both result in nothing being printed when the printing is aborted**).

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being obvious over Hoene in view of Cousins.

In regard to claim 23, neither Hoene, Cousins, or AAPA discloses wherein said photo printing judgment unit is operable to judge that the photo printing is intended, when the type of the print medium is a label of an information recording medium.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Hoene for judging that the photo printing is intended, when the type of the print medium is a label of an information recording medium in order to widen the application of the apparatus disclosed in Hoene.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure and is as follows:

Iwasaki et al., U.S. Patent Application Publication No. 2005/0018012 A1, teaches detecting image type and image medium type.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571)-272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. R./

Examiner, Art Unit 4146

08/14/2009

Application/Control Number: 10/591,256

Page 19

Art Unit: 4146

/Nabil El-Hady/

Supervisory Patent Examiner, Art Unit 4146